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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,687	12/06/2005	Bruno Frederic Stengel	JMYS-129US	8391
23122	7590	06/20/2007		
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			EXAMINER GILLESPIE, BENJAMIN	
			ART UNIT 1711	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,687	Applicant(s) STENGEL ET AL.	
	Examiner Benjamin J. Gillespie	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6, 10 and 11 is/are allowed.
- 6) ☒ Claim(s) 5, 7, 8 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/6/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language “the molar ratio of acid to titanium or zirconium in the reaction product is from 1 to 4 moles acid per mole of titanium, zirconium, hafnium, aluminum, iron (III), or lanthanide” renders the claim indefinite because it is unclear as to what metal compounds are considered when calculating the molar ratio of the acid.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1711

3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
5. Claims 8 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/537,651. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a catalyst composition comprising the reaction product of alkoxide of a metal, 2-hydroxycarboxylic acid, polyol, and a base.
6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7-8, 12-14 rejected under 35 U.S.C. 102(b) as being anticipated by Ridland (EP 1 120 392 A1). Ridland teaches a catalyst composition comprising the reaction product of

Art Unit: 1711

titanium or zirconium alkoxide, 2-hydroxy carboxylic acid, a base, and an alcohol having at least two hydroxyl groups (Paragraphs 1, 4, and 5). Furthermore, Ridland teaches that the catalyst composition is useful in promoting ester reactions between carboxylic acid and hydroxyl containing compounds such as ethylene glycol or 1,4-butanediol (Paragraph 12). These polyfunctional hydroxyl-containing compounds inherently share the same isocyanate reactive characteristics of a) i) of claim 7. Finally, Ridland teaches that solvent may be present during esterification (Paragraph 23).

8. Claims 7-8, 12-14 rejected under 35 U.S.C. 102(b) as being anticipated by Ridland (GB 2,314,081 A). Ridland teaches a catalyst composition comprising the reaction of titanium or zirconium alkoxide, 2-hydroxy carboxylic acid, a base, and an alcohol having at least two hydroxyl groups (Abstract; page 1 lines 16-20). Furthermore, Ridland teaches that the catalyst composition is useful in promoting ester reactions between carboxylic acid and hydroxyl containing compounds such as ethylene glycol or 1,4-butanediol (Page 4 lines 6-7). These polyfunctional hydroxyl-containing compounds inherently share the same isocyanate reactive characteristics of a) i) of claim 7. Finally, Ridland teaches that solvent may be present during esterification (Page 8 lines 5-7).

9. Claims 7-8, 12-14 rejected under 35 U.S.C. 102(b) as being anticipated by Ridland (EP 0 812 818 A1). Ridland teaches a catalyst composition comprising the reaction product of titanium or zirconium alkoxide, 2-hydroxy carboxylic acid, a base, and an alcohol having at least two hydroxyl groups (Abstract; page 2 lines 11-14). Furthermore, Ridland teaches that the catalyst composition is useful in promoting ester reactions between carboxylic acid and hydroxyl containing compounds such as ethylene glycol or 1,4-butanediol (Page 2 lines 39-48). These

Art Unit: 1711

polyfunctional hydroxyl-containing compounds inherently share the same isocyanate reactive characteristics of a) i) of claim 7. Finally, Ridland teaches that solvent may be present during esterification (Page 3 lines 41-42).

Allowable Subject Matter

10. Claims 1-4, 6, 10 and 11 are allowed. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Gillespie whose telephone number is 571-272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/537,687

Page 6

Art Unit: 1711

B. Gillespie


RABON SERGENT
PRIMARY EXAMINER